

### REMARKS

The present application includes pending claims 1-20, all of which remain rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 remain rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,755,744 ("Nathan"). Claims 4, 9, 12, 15, and 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan. The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and the following:

**I. The Present Application Claims Priority Benefits From Applications Having Effective Filing Dates That Antedate Nathan**

Initially, the Applicant notes that the present application claims priority to United States Serial No. 09/309,400, filed May 11, 1999, United States Serial No. 09/502,875, filed February 11, 2000, and **United States Serial No. 09/426,047, filed October 25, 1999**. The filing dates of all of these parent applications antedate the filing date, and even the foreign priority dates, of Nathan.

The Applicant directs the Examiner to **United States Serial No. 09/426,047, which was filed October 25, 1999 (the '047 application)**. The '047 application, in particular, supports all of the pending claims 1-20 of the present application. For example, the '047 application recites the same claims 1-17 as originally presented in the present application. Additionally, the disclosure of the '047 application supports all of claims 1-20 that are now pending. Thus, the present application claims priority to other applications, particularly, United States Serial No. 09/426,047, which has an earlier

effective filing date than Nathan. As such, the Applicant respectfully submits that Nathan is not prior art with respect to the present application.

**II. Nathan Does Not Explicitly Or Inherently Describe A Single Control Subsystem Coupled To A Game Subsystem And A Jukebox Subsystem That Exercises Control Over The Game And Jukebox Subsystems**

The Office Action states the following:

Nathan clearly discloses a communication device and method for switching operating modes between an electronic game machine and a jukebox (column 3). Nathan describes switching from a game function to a jukebox function for selecting and playing music or to pay for credits in order to be able to play a game or a song in the event that none exists (column 4, lines 20-37).

November 3, 2005 Office Action at page 4.

The Applicant respectfully disagrees that Nathan describes switching from a game function to a jukebox function for **playing music**. Nathan relates to a “communication device allowing game machines to be used as terminals for the playback system.” Nathan at column 1, lines 26-30. Notably, Nathan only describes a system in which a game machine may be used as a terminal for a playback system, but does not describe a system in which a single control subsystem exercises control over both a game subsystem and a jukebox subsystem.

As discussed previously, Nathan discloses a system in which separate electronic game machines may be used as an add-on device for jukebox selection and payment.

The principle of the invention is that these electronic game machines 2 can be used as **add-on selection means and means of payment for a jukebox**, located nearby, in the same bar as the electronic game machines 2.

*Id.* at column 2, lines 45-48.

The electronic game machines may be used to select between two operating modes of the game machine. *See id.* at column 2, lines 48-50 (“Thus, each electronic

game machine comprises a means for selecting between two operating modes.”). One of the modes relates to **operation of the electronic game machine**, and the other mode relates to **selection and payment regarding the jukebox**.

The first operating mode corresponds to the original operating mode of the electronic game machine, i.e., the machine is operating as an electronic game or an internet access station. In this mode and according to a first alternative embodiment, no communication is taking place between the jukebox 1 and the electronic game machine 2. In the second operating mode, the electronic game machine 2 is converted into an add-on selection means and a means of payment for the jukebox. **In this mode, all the original functionalities are unused to allow for the selection and payment functions of the jukebox 2.**

*Id.* at column 2, lines 50-60 (emphasis added). Thus, Nathan discloses a system in which a game machine may be operated (1) in its normal operating mode, in which the game machine does NOT communication with the jukebox, and (2) in a jukebox selection and payment mode in which it may be used **only for selection and payment** with respect to the jukebox. Nathan clearly states that in this second mode, the game machine is only used for selection and payment. *See, e.g.*, Nathan at column 3, lines 49-54 (“... of the operation of the electronic game machine 2 in the second operating mode, i.e., in the mode allowing the selection and payment for pieces of music from the jukebox 1.”).

Nathan discloses a system in which a game machine may be used in a first mode, which is its normal game operating mode without communication with the jukebox, and a second mode, in which it may be used to select and pay for musical pieces contained within the jukebox.

Nathan, however, does not explicitly or inherently describe “a single control subsystem coupled to the game subsystem and the jukebox subsystem... exercising control over the game subsystem and the jukebox subsystem,” such as recited in claim 1.

While Nathan discloses a system in which a user may select songs and pay for songs from a game machine, Nathan does not disclose a single control subsystem that exercises control over both the game machine and the jukebox. In short, allowing selection and payment with respect to a jukebox from a separate game machine is not the same as controlling jukebox and game functionality through a **single control subsystem**.

The Office Action states:

Although applicant has added the term “single” preceding control subsystem in the after final amendment filed, the recitation of the claim is directed to the manner in which it is intended to be used and does not distinguish over the prior art. Further clarification of the claimed subject matter, avoiding intended use language may distinguish the claim and further define applicant’s claimed subject matter. See MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987).

November 3, 2005 Office Action at page 3.

The Applicant respectfully disagrees that “single control subsystem” is directed to an intended use and is not a structural limitation of the claim. The case cited in the Office Action in support of the Examiner’s assertion, *Ex Parte Masham*, 2 USPQ2d 1647 (B.P.A.I. 1987), is dissimilar from the present situation. In *Ex Parte Masham*, a prior art mixing device included the same structural limitations as the claimed subject matter. *Id.* The only difference between the prior art mixer and the claimed mixer was an intended use limitation that the claimed mixer be “completely submerged” during use, the prior art mixer being only partially submerged during use. *Id.* The term “single control subsystem” is a structural limitation, and *Ex Parte Masham* is not applicable to the Applicant’s claims.

Thus, at least for these reasons, the Applicant respectfully submits that Nathan does not anticipate, or render unpatentable, claims 1, 11, or the claims that depend therefrom.

### III. Nathan Teaches Away From Some Types Of Electronic Dart Games

Turning now to the rejection of claims 4, 9, 12, and 15, Nathan is clear that the electronic game machines disclosed in Nathan **must** include a viewing means, such as a video monitor. For example, Nathan discloses the following:

As a minimum, each electronic game machine 2 **must** originally comprise a **viewing means** 210, such as a **video monitor**, a means for interacting with a user 211, and its own means of payment 220.

Nathan at column 2, lines 38-42 (emphasis added). The Applicant notes, in particular, the use of the word “must.” Nathan requires a “viewing means” that allows the viewing of “specific selection screens.”

Indeed, the second operating mode **requires** the viewing of **specific selection screens** as well as different management of the means of payment in comparison with the first operating mode of the electronic game machine 2.

*Id.* at column 3, lines 37-40 (emphasis added). The Applicant notes the use of the word “requires.” In order to view a “selection screen,” the viewing means **must** be capable of showing such a selection screen.

The Examiner states:

Nathan does not limit the invention to any specific type of electronic game and discloses a video monitor as one example of a viewing means, “such as a video monitor...”). Thus applicant’s argument limiting Nathan’s invention to solely a video monitor is simply erroneous.

November 3, 2005 Office Action at page 5. The only viewing means disclosed by Nathan, however, is a video monitor. *See generally* Nathan.

The Office Action further states that “it is noted that the features upon which applicant relies... are not recited in the rejected claim(s).” *See* November 3, 2005 Office Action at page 5. The Applicant respectfully disagrees. Claims 4, 9, 12, and 15 all recite dart games. Electronic dart game machines may or may not include a separate viewing means, such as a video monitor, that is capable of showing a selection screen. In fact, various electronic dart game machines exist that do not include a viewing means that is capable of showing a selection screen. **Clearly, if Nathan would have considered electronic dart game machines, it certainly would have left open the possibility for those dart game machines that do not include a viewing means that are capable of showing a selection screen.**

Nathan, however, does not mention dart game machines at all, and **requires** that its game machines include a viewing means, such as a video monitor (as this is the only “viewing means” that Nathan discloses), that is capable of showing a selection screen. Thus, it would **not** be obvious to combine a dart game with Nathan, because an entire class of electronic dart games, such as those without viewing means capable of showing a selection screen, are precluded from being used with Nathan. Had Nathan contemplated use of dart games, Nathan clearly would have left open the possibility of utilizing games without the viewing means, because numerous types of electronic dart games do not include a viewing means (i.e., the video monitor disclosed in Nathan) that is capable of showing a selection screen. As such, the Applicant respectfully submits that Nathan does not render claims 4, 9, 12, and 15 unpatentable at least for this reason.

**IV. Incorporating A Game Subsystem And Jukebox Subsystem Into A Single Unit Is Not Merely A Matter Of Engineering Design Choice**

The Applicant next turns to the rejection of claims 18-20. Initially, the Applicant notes that these claims should be in condition for allowance, at least for the reasons discussed above with respect to claims 1 and 11. The Office Action concedes that “Nathan does not explicitly [sic, disclose] a single unit housing the integral part of the entertainment system,” but asserts that “it has been well settled that by providing a single unit or housing for making integral structures disclosed in the prior art would be merely a matter of obvious engineering choice.” *See* November 3, 2005 Office Action at page 10.

Claim 18 recites a “single unit” that houses the game subsystem, the jukebox subsystem, and the control subsystem. The Applicant respectfully submits that housing the game subsystem and the jukebox subsystem in a single unit is not merely a matter of obvious design choice. First, such game systems and jukebox systems are not normally linked to one another. Next, even Nathan describes game systems and jukebox systems as being separate and distinct. *See* Nathan, e.g., at column 2, lines 45-48 (“The principle of the invention is that these electronic game machines 2 can be used **as add-on** selection means and means and means of payment **for a jukebox 1, located nearby**, in the same bar as the electronic game machines 2.). Nathan simply does not teach or suggest that such systems could be housed within a single unit.

Overall, there has been a need for maximizing the floor space within an establishment, and to reduce the number of operational gaming systems in an establishment, as described in the background section of the present application. *See, e.g.,* present application at ¶¶ [0005 – 0006] (“Electronic entertainment devices and jukeboxes, however, occupy valuable floor space that could otherwise be profitably used,

for example, for additional customer seating.... Reducing the number of operational gaming systems in an entertainment establishment may in many instances reduce overall operating expenses”). Housing a gaming system and a jukebox system into a single unit addresses these needs, and should therefore be patentable. *See Shenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed.Cir. 1983).

The cases on which the Office Action relies, *In re Larson*, 144 USPQ 347 (C.C.P.A. 1965) and *In re Wolfe*, 116 USPQ 443 (C.C.P.A. 1958), are inapplicable to the Applicant’s claims. In *In re Larson*, the court rejected a claim to a one-piece handle for a massage device because the prior art disclosed a handle for a massage device that was the same except that the prior art handle consisted of two pieces fastened together. 144 USPQ 347 (C.C.P.A. 1965) (holding “merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable”). In *In re Wolfe*, the court rejected a claim to a “brake drum integral with a said clamping means” because “the term ‘integral’ is not limited to a fabrication of the parts from a single piece of metal, but is inclusive of other means for maintaining the parts fixed together as a single unit.” 116 USPQ 443 (“While the brake disc and clamp of [the prior art] comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole.”)

Claims 18-20 are not directed to components fabricated from a single piece of material that have been previously joined to one another through some other means. Claims 18-20 are directed to a single unit that comprises a game subsystem, a jukebox subsystem, and a single control subsystem, which have never before been contained within a single unit. In other words, the term “single unit”, is not directed to the manner



in which the components of the single unit are fastened or connected to one another. Rather, term "single unit" is directed to the very idea of bringing the components together in the first instance. Thus, neither *In re Larson* nor *In re Wolfe*, are applicable to claims 18-20.

Thus, at least for these reasons, claims 18-20 should be in condition for allowance.

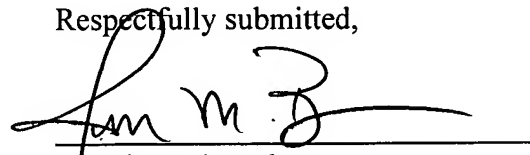
**V. Conclusion**

The Applicant respectfully submits that claims 1-20 of the present application should be in condition for allowance at least for the reasons discussed above and request reconsideration of the claim rejections. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the Applicant. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Date: January 30, 2006

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Respectfully submitted,



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